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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/080,522	02/25/2002	Russel E. Kaufman	1579-645	8638
23117	7590	10/25/2004	EXAMINER	
NIXON & VANDERHYE, PC 1100 N GLEBE ROAD 8TH FLOOR ARLINGTON, VA 22201-4714			HELMS, LARRY RONALD	
			ART UNIT	PAPER NUMBER
			1642	

DATE MAILED: 10/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/080,522	<b>Applicant(s)</b> KAUFMAN ET AL.	
	<b>Examiner</b> Larry R. Helms	<b>Art Unit</b> 1642	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 1-20, 23-28, 31 and 32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21, 22, 29 and 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 January 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/25/02</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Applicant's election with traverse of Group III, claims 21-22, 29-30 in the reply filed on 7/26/04 is acknowledged. The traversal is on the ground(s) that Groups III and V should be examined together and no undue burden would be placed on the examiner. This is not found persuasive because as stated in the restriction requirement the groups are distinct based on classification as well as the fact that the antibody can be used for a different method as stated in the restriction requirement. Therefore, the restriction is maintained and it is acknowledged that Group V can be rejoined when Group III claims are allowable. Applicants attention is directed to paragraph 4 of the restriction requirement for rejoinder practice.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-20, 23-28, 31-32 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 7/26/04.

3. Claims 21-22 and 29-30 are under examination.

### ***Specification***

4. The disclosure is objected to because of the following informalities:

a. The first line of the specification needs to be updated to indicate application 09/539,774 is now US Patent 6,350,615.

b. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

c. Although this application appears to be in sequence compliance, it is requested that either the Figures or the Brief Description of the Drawings include any SEQ ID NOs that are in the Figures.

d. The ATCC address needs to be updated on page 15 to the American Type Culture Collection, 10801 University Boulevard, Manassas, VA 20110-2209

Appropriate correction is required.

### ***Claim Objections***

5. Claims 21-22 are objected to because of the following informalities: Claims 21 and 22 depend on non-elected claim 19. For examination all of the dependencies of claim 19 will be read into claim 21 and 22.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 21-22, 29-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims encompass an antibody to any mammalian K12 protein or any compound that binds to K12 protein. There is insufficient written description encompassing "mammalian K12 protein" because the relevant identifying characteristics of the genus of such a structure is not given except for SEQ ID NO:1. In addition the only "compound that specifically binds to K12" is an antibody to SEQ ID NO:1. The identifying characteristics of the mammalian K12 protein or other physical and/or chemical characteristics of the protein are not set forth in the specification as-filed, commensurate in scope with the claimed invention. Vas-Cath Inc. v. Mahurkar, 19 USPQ2d 1111, makes clear that "applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the 'written description' inquiry, whatever is now claimed." (see page 1117). The specification does not "clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." (see Vas-Cath at page 1116).

Adequate written description requires more than a mere statement that it is part of the invention and reference to a potential method for isolating it. See Fiers v. Revel,

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25 USPQ2d 1601, 1606 (CAFC 1993) and Amgen Inc. v. Chugai Pharmaceutical Co. Ltd., 18 USPQ2d 1016.

One cannot describe what one has not conceived. See Fiddles v. Baird, 30 USPQ2d 1481, 1483. In Fiddles v. Baird, claims directed to mammalian FGF's were found unpatentable due to lack of written description for the broad class. The specification provided only the bovine sequence. Thus, the specification fails to describe these DNA sequences. The Court further elaborated that generic statements are not adequate written description of the genus because it does not distinguish the claimed genus from others, except by function. Finally, the Court indicated that while applicants are not required to disclose every species encompassed within a genus, the description of a genus is achieved by the recitation of a representative number of DNA molecules, defined by nucleotide sequence, falling within the scope of the genus, See The Regents of the University of California v. Eli Lilly and Company, 43 USPQ2d 1398, 1406 (Fed. Cir. 1997).

Applicant is relying upon SEQ ID NO:1 as a species to support an entire genus of mammalian K12 protein for which applicant only had the human protein of SEQ ID NO:1. In addition the specification only teaches an antibody to SEQ ID NO:1 as a compound that binds. There is no other compound as broadly encompassed by small molecules, peptides, etc that are described in the specification that is a compound that binds.

With respect to a compound that would be suitable for use in the claimed invention, per the *Enzo* court's example of a description of an anti-inflammatory steroid

couched "in terms of its function of lessening inflammation of tissues," which, the court stated, "fails to distinguish any steroid from others having the same activity or function," and which therefore, fails to satisfy the written-description requirement. Similarly, "a compound that inhibits specific binding between a signal-transducing protein and a cytoplasmic protein..." does not distinguish the compound from others having the same activity or function and as such does not satisfy the written-description requirement. Mere idea or function is insufficient for written description; isolation and characterization at a minimum are required. The identity of the compound, and the description must convey what the compound is, and not just what it does. The instant application discloses no more than a hoped-for function (binding) for an as-yet-to-be-discovered compound.

The guidelines for the Examination of Patent Applications Under the 35 U.S.C. 112 first paragraph "written description" requirement make clear that if a claimed genus does not show actual reduction to practice for a representative number of species; then the requirement may be alternatively met by reduction to drawings, or by disclosure of relevant, identifying characteristics, i.e., structure or other physical and/or chemical properties, by functional characteristics coupled with a known or disclosed correlation between function and structure or by a combination of such identifying characteristics, sufficient to show the applicant was in possession of the genus (Federal register, Vol. 66, No. 4, pages 1099-1111, Friday January 5, 2001, see especially page 1106 column 3).

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In the absence of structural characteristics that are shared by members of the genus of mammalian K12 proteins or compounds that bind to K12; one of skill in the art would reasonably conclude that the disclosure fails to provide a representative number of species to describe the genus. Thus, Applicant was not in possession of the claimed genus. See University of California v. Eli Lilly and Co. 119 F.3d 1559, 43 USPQ2d 1398 (Fed. Cir. 1997).

Applicant is reminded that Vas-Cath makes clear that the written description provision of 35 U.S.C. 112 is severable from its enablement provision (see page 1115).

8. Claim 22 is rejected under 35 U.S.C. § 112, first paragraph, because the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention, because the specification does not provide evidence that the claimed biological materials are (1) known and readily available to the public; (2) reproducible from the written description.

It is unclear if a cell line which produces an antibody having the exact chemical identity of 7C3 is known and publicly available, or can be reproducibly isolated without undue experimentation. Therefore, a suitable deposit for patent purposes is suggested. Without a publicly available deposit of the above cell line, one of ordinary skill in the art could not be assured of the ability to practice the invention as claimed. Exact replication of: (1) the claimed cell line; (2) a cell line which produces the chemically and functionally distinct antibody claimed; and/or (3) the claimed antibody's amino acid or nucleic acid sequence is an unpredictable event.



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For example, very different VH chains (about 50% homologous) can combine with the same VK chain to produce antibody-binding sites with nearly the same size, shape, antigen specificity, and affinity. A similar phenomenon can also occur when different VH sequences combine with different VK sequences to produce antibodies with very similar properties. The results indicate that divergent variable region sequences, both in and out of the complementarity-determining regions, can be folded to form similar binding site contours, which result in similar immunochemical characteristics. [FUNDAMENTAL IMMUNOLOGY 242 (William E. Paul, M.D. ed., 3d ed. 1993)]. Therefore, it would require undue experimentation to reproduce the claimed antibody species 7C3. Deposit of the hybridoma would satisfy the enablement requirements of 35 U.S.C. § 112, first paragraph. See, 37 C.F.R. 1.801-1.809.

Applicants referral on page 15 that the hybridoma producing the 7C3 antibody has been deposited at the ATCC is not persuasive because all of the assurances have not been met.

If the deposit is made under the provisions of the Budapest Treaty, filing of an affidavit or declaration by applicant or assignees or a statement by an attorney of record who has authority and control over the conditions of deposit over his or her signature and registration number stating that the deposit has been accepted by an International Depository Authority under the provisions of the Budapest Treaty and that all restrictions upon public access to the deposited material will be irrevocably removed upon the grant of a patent on this application. This requirement is necessary when deposits are made

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under the provisions of the Budapest Treaty as the Treaty leaves this specific matter to the discretion of each State.

If the deposit is not made under the provisions of the Budapest Treaty, then in order to certify that the deposits comply with the criteria set forth in 37 CFR 1.801-1.809 regarding availability and permanency of deposits, assurance of compliance is required. Such assurance may be in the form of an affidavit or declaration by applicants or assignees or in the form of a statement by an attorney of record who has the authority and control over the conditions of deposit over his or her signature and registration number averring:

(a) during the pendency of this application, access to the deposits will be afforded to the Commissioner upon request:

(b) all restrictions upon the availability to the public of the deposited biological material will be irrevocably removed upon the granting of a patent on this application:

(c) the deposits will be maintained in a public depository for a period of at least thirty years from the date of deposit or for the enforceable life of the patent or for a period of five years after the date of the most recent request for the furnishing of a sample of the deposited biological material, whichever is longest; and

(d) the deposits will be replaced if they should become nonviable or non-replicable.

Amendment of the specification to recite the date of deposit and the complete name and address of the depository is required. As an additional means for completing the record, applicant may submit a copy of the contract with the depository for deposit and maintenance of each deposit.

If a deposit is made after the effective filing date of the application for patent in the United States, a verified statement is required from a person in a position to

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corroborate that the biological material described in the specification as filed is the same as that deposited in the depository, stating that the deposited material is identical to the biological material described in the specification and was in the applicant's possession at the time the application was filed.

Applicant's attention is directed to In re Lundak, 773 F.2d. 1216, 227 USPQ 90 (CAFC 1985) and 37 CFR 1.801-1.809 for further information concerning deposit practice.

9. Claims 21-22 and 29-30 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an antibody that binds SEQ ID NO:1 or a fragment of at least 5 amino acids of SEQ IS NO:1 wherein the antibody can be 7C3, with completion of the deposit requirements, does not reasonably provide enablement for just any compound that binds to just any K12 protein or an antibody to just any mammalian K12 protein. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Factors to be considered in determining whether undue experimentation is required, are summarized in Ex parte Forman, 230 USPQ 546 (BPAI 1986). They include the nature of the invention, the state of the prior art, the relative skill of those in the art, the amount of direction or guidance disclosed in the specification, the presence or absence of working examples, the predictability or unpredictability of the art, the

breadth of the claims, and the quantity of experimentation which would be required in order to practice the invention as claimed.

The claims are broadly drawn to an antibody or any compound that binds to just any K12 protein or a mammalian K12 protein.

The specification teaches only SEQ ID NO:1 as the human K12 protein and only an antibody as a compound that binds to SEQ ID NO:1 (see Figure 1 and Example IV)

The claims are not commensurate in scope with the enablement provided in the specification because the specification does not disclose a function of the K12 protein or what identifying characteristics would be needed for one to have a K12 protein.

Although the amino acid sequence of SEQ ID NO:1 is disclosed, there's no indication as to what parts of the protein are required to have a "K12" protein. The structure of the protein is required for a function to be determined and as evidenced from the following discussion protein chemistry is probably one of the most unpredictable areas of biotechnology.

For example, the replacement of a single lysine at position 118 of the acidic fibroblast growth factor by a glutamic acid led to a substantial loss of heparin binding, receptor binding, and biological activity of the protein (see Burgess et al, Journal of Cell Biology Vol 111 November 1990 2129-2138). In transforming growth factor alpha, replacement of aspartic acid at position 47 with asparagine, did not affect biological activity while the replacement with serine or glutamic acid sharply reduced the biological activity of the mitogen (see Lazar et al Molecular and Cellular Biology Mar 1988 Vol 8 No 3 1247-1252). Replacement of the histidine at position 10 of the B-chain of human

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insulin with aspartic acid converts the molecule into a superagonist with 5 times the activity of nature human insulin. Schwartz et al, Proc Natl Acad Sci USA Vol 84:6408-6411 (1987). Removal of the amino terminal histidine of glucagon substantially decreases the ability of the molecule to bind to its receptor and activate adenylate cyclase. Lin et al Biochemistry USA Vol 14:1559-1563 (1975).

These references demonstrate that even a single amino acid substitution or what appears to be an inconsequential chemical modification, will often dramatically affect the biological activity of the protein.

The claims encompass an antibody or any compound that binds to any K12 protein and as evidenced from the above discussion it would be unpredictable what other proteins are a K12 protein. In addition, the specification has not disclosed any other "compound" that would bind to SEQ ID NO:1 that could be used for detection of SEQ ID NO:1

Therefore, in view of the unpredictability in the art of protein chemistry as indicated above, and in view of the lack of guidance in the specification and in view of the broadly claimed invention, it would require undue experimentation to practice the broadly claimed invention.

### ***Claim Rejections - 35 USC § 101***

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. Claims 21-22 are rejected under 35 U.S.C. ' 101 because the claimed invention

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is directed to non-statutory subject matter.

Claims 21-22 as written, do not sufficiently distinguish over antibodies as they exists naturally because the claim does not particularly point out any non-naturally occurring differences between the claimed antibodies and binding compositions and the structure of naturally occurring antibodies.

In the absence of the hand of man, the naturally occurring antibodies are considered non-statutory subject matter (Diamond v. Chakrabarty, 206 U.S.P.Q. 193 (1980)). It should be noted that the mere purity of a naturally occurring product does not necessarily impart patentability (Ex parte Siddiqui, 156 U.S.P.Q. 426 (1966)). However, when purification results in a new utility, patentability is considered (Merck Co. v. Chase Chemical Co., 273 F.Supp 68 (1967), 155 USPQ 139, (District Court, New Jersey, 1967)). Amendment of the claim to recite "an isolated" or "purified" antibody or similar language would obviate this rejection.

### ***Conclusion***

12. No claim is allowed.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Larry R. Helms, Ph.D, whose telephone number is (571) 272-0832. The examiner can normally be reached on Monday through Friday from 6:30 am to 4:00 pm, with alternate Fridays off. If attempts to reach the examiner by


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telephone are unsuccessful, the examiner's supervisor, Jeffery Siew, can be reached at (571) 272-0787.

14. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Fax Center telephone number is 703-872-9306.

Larry R. Helms

571-272-0832



LARRY R. HELMS, PH.D  
PRIMARY EXAMINER